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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/270,834	03/18/1999	MASAHITO NIIKAWA	032567-007	3006

21839 7590 06/06/2006

BUCHANAN INGERSOLL PC
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EXAMINER

WHIPKEY, JASON T

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/270,834

Applicant(s)

NIIKAWA ET AL.

Examiner

Jason T. Whipkey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 20, 21, 23, 24 and 26-29 is/are allowed.
- 6) ☒ Claim(s) 5-7, 15, 16, 22 and 25 is/are rejected.
- 7) ☒ Claim(s) 8-14 and 17-19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed March 13, 2006, with respect to the rejection of claims 1-4, 20, 21, 23, 24, and 26-29 have been fully considered and are persuasive. The rejection of these claims has been withdrawn.
2. Applicant's arguments with respect to claims 5-7, 15, and 16 have been considered but are moot in view of the new grounds of rejection.
3. Applicant's arguments filed March 13, 2006, with respect to the rejection of claims 22 and 25 under 35 U.S.C. 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground of rejection is made in view of Creamer (U.S. Patent No. 2005/0078189).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 5 and 6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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Claims 5 and 6 recite a computer program but lack a storage medium upon which the program is stored.

Computer programs are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer that permit the computer program’s functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory. See In re Lowry, 32 F.3d 1583-84, 32 USPQ2d 1035.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language:

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7. Claims 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Parulski (U.S. Patent No. 5,402,170).

Regarding **claim 5**, Parulski discloses a computer program product based on which a computer (12 in Figure 1), which is connectable to a camera (10) for photographing an object and acquiring image data of the object, executes the steps (computers inherently use programs comprised of steps in order to perform a task) of:

receive a command signal (which instructs the computer to store an image; see column 4, lines 3-5) transmitted by the camera (via the capture out line) connected to the computer; and

display a folder for storing image data transmitted from the camera (a mosaic of thumbnails of received images is displayed; see column 6, lines 37-40), on a display functioning together with the computer, based on the command signal transmitted by the camera (the mosaic is automatically displayed when the camera instructs the computer to store an image and the computer lacks sufficient disk space; see column 6, lines 30-39).

Regarding **claim 6**, Parulski discloses:

warning data is transmitted to the camera when a capacity of the folder is not enough (instructions to illuminate fault lamp 38c are transmitted to the camera when there is insufficient storage space; see column 6, lines 30-32).

8. Claims 22 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Creamer (U.S. Patent Application Publication No. 2005/0078189).

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Regarding **claim 22**, Creamer discloses a camera system, comprising:

a camera (see Figure 3) for photographing an object and acquiring image data of the object;

a computer (running shell 306; see paragraphs 106-107) connectable to said camera (via an intranet 316);

a memory (NVRAM 242) provided in said camera (see Figure 3), said memory registering an operation to specify a folder (an upload destination directory) for transferring the image data to said computer (see paragraphs 110-111); and

a manipulation member (release button 214e) which calls a registered content (uploading instructions inherently present in the camera) from said memory and specifies the operation (i.e., uploading) based on the registered content when said manipulation member is operated (upon image capture, images may be directly uploaded to the destination directory on the server; see paragraphs 81 and 111).

Regarding **claim 25**, Creamer discloses a camera system (see Figure 3), comprising:

a connector (network interface device 236) connectable to a computer (via an intranet 316 and running shell 306; see paragraphs 106-107);

a memory (NVRAM 242) for registering an operation for the computer (uploading instructions inherently present in the camera, since it is capable of uploading images to the server; see paragraph 111);

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a memory (NVRAM 242) for registering an operation to specify a folder for transferring image data to the computer (an upload destination directory; see paragraphs 110-111); and

a manipulation member (release button 214e) which calls a registered content from said memory and specifies the operation based on the registered content when said manipulation member is operated (upon image capture, images may be directly uploaded to the destination directory on the server; see paragraphs 81 and 111).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 7, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imaeda (U.S. Patent No. 5,473,366) in view of Shibata (U.S. Patent Application Publication No. 2002/0018114).

Regarding **claim 7**, Imaeda discloses a system, including:

- a camera (TV telephone main body 101; see Figure 2) for photographing an object and acquiring image data of the object (see column 5, lines 17-18);

- a computer (the remote system identical to the one in Figure 2) connectable to said camera (via an external communication line; see column 5, lines 61-62);

- an image display (219) provided on said camera;

- a controller (overall control unit 201 in the remote system) provided to said computer for detecting a connection of said camera to said computer and automatically (see column 6, lines 20-23) transmitting display data stored in said computer to said camera based on the detected results (see column 7, lines 47-59); and

- a camera controller (overall control unit 201 in the local system) provided to said camera for controlling a screen of said image display based on the display data received from said computer (see column 7, lines 55-65).

Imaeda is silent with regard to changing the number of pixels of in the received display data.

Shibata discloses a video teleconferencing device, wherein each terminal:

controls a screen of said image display (see figures 4(a)-4(f)) based on the display data received from said computer (the remote terminals; see paragraph 98) while changing the number of pixels of the display data on the image display of the camera different from a display functioning together with said computer (the local terminal [which has a camera] displays an image received from a remote terminal's computer with the number of pixels reduced by minor-frame address generator 309, which generates skipped addresses to thin out received image data; see paragraphs 98 and 101).

An advantage of changing the number of pixel of display data displayed is that additional information may also be displayed on the screen. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Imaeda's system change the number of pixels of the display data displayed.

Regarding **claim 15**, Imaeda discloses a device, including:

a connector connectable to a computer (communication control unit 212 in Figure 1);

an image display (219); and

a camera controller (overall control unit 201) for receiving display data transmitted automatically from a computer (a remote system identical to the one in Figure 1; see column 6, lines 20-23) when connected to said connector and

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controlling a screen of said image display based on the received display data (see column 7, lines 47-65).

Imaeda is silent with regard to changing the number of pixels of in the received display data.

Shibata discloses a video teleconferencing device, wherein each terminal:

controls a screen of said image display (see figures 4(a)-4(f)) based on the received display data (see paragraph 98) while changing the number of pixels of the display data on the image display of the camera different from a display functioning together with said computer (the local terminal [which has a camera] displays an image received from a remote terminal's computer with the number of pixels reduced by minor-frame address generator 309, which generates skipped addresses to thin out received image data; see paragraphs 98 and 101).

An advantage of changing the number of pixel of display data displayed is that additional information may also be displayed on the screen. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Imaeda's system change the number of pixels of the display data displayed.

Regarding **claim 16**, Shibata discloses:

said camera controller changes the number of pixels of the display data by thinning out the display data (minor-frame address generator 309 generates skipped addresses to thin out received image data; see paragraph 101).

Allowable Subject Matter

12. Claims 1-4, 20, 21, 23, 24, and 26-29 are allowed.

Regarding claims 1-4, no prior art could be located that teaches or fairly suggests a camera connectable to a computer, wherein a manipulation member on the camera is detected by a controller that causes a signal to be transmitted to the computer for controlling its display screen.

Regarding claims 20, 21, 23, 24, and 26-29, no prior art could be located that teaches or fairly suggests a camera connectable to a computer with a manipulation member, wherein the camera has a memory that registers an operation for the computer that corresponds to an operation activated by the manipulation member, wherein the manipulation member calls registered content from the memory to activate the corresponding operation.

13. Claims 8-14 and 17-19 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claims 8-11, no prior art could be located that teaches or fairly suggests a camera system including a connected computer, wherein a controller in the computer transmits display data to the camera automatically whenever a connection is detected, and wherein an image display on the camera thins out display data based on the difference between the number of pixels of a camera display and the number of pixels of a computer display.

Regarding claims 12-14, no prior art could be located that teaches or fairly suggests a camera system including a connected computer, wherein a controller in the computer transmits

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display data to the camera automatically whenever a connection is detected, and wherein warning data is transmitted to the camera when sufficient storage capacity does not exist.

Regarding claim 17, no prior art could be located that teaches or fairly suggests a camera that receives display data transmitted automatically from a computer upon connection, wherein image data displayed on the camera is thinned out without thinning out the image of a mouse cursor display.

Regarding claims 18 and 19, no prior art could be located that teaches or fairly suggests a camera that receives display data transmitted automatically from a computer upon connection, wherein image data displayed on the camera is *thinned out at a rate* in response to an operation of a manipulation member on the camera.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Kondo (U.S. Patent No. 6,151,652) discloses a camera that automatically transfers images to a computer.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason T. Whipkey, whose telephone number is (571) 272-7321. The examiner can normally be reached Monday-Friday from 8 A.M. to 5:30 P.M. eastern daylight time.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Ometz, can be reached at (571) 272-7593. The fax phone number for the organization where this application is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JTW

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May 30, 2006


TUAN HO
PRIMARY EXAMINER